

Restriction Requirement.

The Examiner has required restriction of the claims of the instant application to one of three groups:

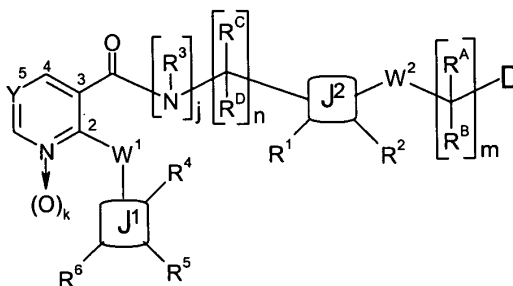
Group I: Claims 1 - 28 in part, drawn to compounds, pharmaceutical compositions and methods of treating wherein Y is =CR¹_a, j is 1, W¹ and W² are O or S(O)_k, J¹ and J² are saturated 6 membered hydrocarbon ring, and R⁵ and R⁶ together form a six membered hetero ring, D is a non-hetero ring containing group, R⁷ is a non-hetero ring containing group and R^A and R^B do not together form a ring, as set forth in the Office Action at page 2;

Group II: Claims 29 and 30, drawn to method of treating and complex compositions as set forth the the Office Action at page 2; and

Group III: Claims 1 - 28 in part, drawn to a different combination of the variables from that given in Group I as set forth in the Office Action at page 2.

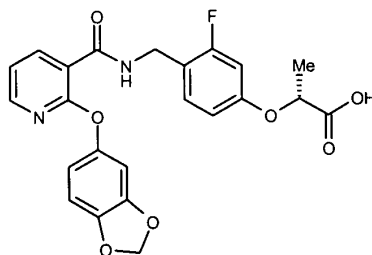
The Examiner further requested election of a species.

In a telephone conversation with the Examiner on November 21, 2002, Applicants' Attorney elected the compound of Example 8, which is Compound (5.5.8). Example 8 is the compound of Formula (1.0.0),



(1.0.0)

wherein Y is CH, k is 0, W¹ is O, J¹ is phenyl, R⁴ is H, R⁵ and R⁶ are taken together to form a group of partial Formula (1.3.1) wherein R²⁰ and R²¹ are each H, R³ is H, j is 1, n is 1, R^C and R^D are each H, J² is phenyl, R¹ is F, R² is H, W² is O m is 1, R^A and R^B are each h and D is carboxy, having the following chemical structure:



The Examiner constructed Group I based upon the election of the compound of Example 8. During the above-mentioned conversation, Applicants' Attorney elected, with traverse, to prosecute the invention of Group I. Applicants note that, at the time, it was agreed that Group I would be limited as follows: Y is CRa¹, j = 1, W¹ and W² are O or S(O)_k, J¹ and J² are each independently a 6-membered hydrocarbon ring, R⁵ and R⁶ are taken together and are a 5-membered *cis*-fused ring containing heteroatoms O, S and/or N, R⁴ is a non-hetero ring

containing group, D is a non-hetero ring containing group, R⁷ is a non-hetero ring containing group, R^A and R^B are not taken together to form a ring. This differs slightly from Group I as set forth in the Office Action, wherein it is stated that R⁵ and R⁶ together form a six membered ring. Applicants submit that the compound of Example 8 is a compound wherein R⁵ and R⁶ form a five-membered ring, as agreed with the Examiner. Accordingly Applicants submit that Group I should be directed to those compounds wherein R⁵ and R⁶ are taken together to form a 5-membered ring. Also, Applicants note that J¹ and J² should not be limited to a saturated ring, particularly since in the compound of Example 8, J¹ and J² are each phenyl. Applicants submit that, in the cases where Group I as presented by the Examiner does not include the elected compound therein that the Examiner expand the scope to include the elected compound. Applicants hereby affirm the election of Group I, with traverse as to the above points.

Amendments:

Entry of the above amendments and reconsideration and withdrawal of the rejection of claims is respectfully requested. Claims 1, 4, 7, 12, 13, 14, 17, 23 and 25 were amended and claims 2, 3, 5, 6, 8, 24 and 26 - 30 were canceled to conform the claims to the group elected in response to the restriction requirement. All amendments and cancellations were made without waiver or prejudice. Applicants reserve the right to file divisional or continuation applications directed to the nonelected or other canceled subject matter of this invention.

Claims 1, 4, 12, 13, 14 and 17 were also amended to limit D to be selected from a group consisting of partial Formulas (1.1.1) to (1.1.5). Claims 20 and 21 were amended to clarify the claim language.

New claims 31 - 40 do not contain any new matter. Support for claims 31 - 39 may be found in original claims 26 - 28. Support for claim 40 may be found in the specification at page 236, Example 8.

As the number of added claims (11) is equal to the number of canceled claims (11), no fee is required for the added claims.

The Objection to the Specification.

The Examiner has objected to the specification alleging that the abstract of the invention as filed does not clearly disclose the elected group. Applicants have replaced the abstract with a new abstract hereinabove. Applicants request that the Examiner reconsider and withdraw the objection to the abstract, as amended.

The Objection to the Claims:

The Examiner has objected to Claims 6 and 8 under 37 C.F.R. §1.175 as being a substantial duplicate of Claim 1. Specifically the Examiner has alleged that J¹ and J² are limited to phenyl. Applicants have canceled Claims 6 and 8, without waiver or prejudice. However, Applicants note that J¹ and J² are, after amendment, limited to a six-membered carbon ring, which includes other rings besides phenyl, e.g., cyclohexyl and cyclohexenyl. Applicants submit that, since Claims 6 and 8 have been canceled hereinabove, this objection is now moot.

The 35 U.S.C. §102(b) rejection.

The Examiner has rejected Claims 1, 4 and 7 - 28 under 35 U.S.C. §102(b) as being anticipated by International Patent Application Publication Number WO01/57036 ("the '036 application"). Specifically, the Examiner has alleged that the '036 application discloses all of the benzofused heterocyclic nicotinamide compounds of the instant invention. Applicants respectfully traverse this rejection with respect to the claims as amended herein.

Initially, Applicants submit that the '036 application does not disclose all of the benzofused heterocyclic nicotinamide compounds of the instant invention. In fact, the '036 application only

discloses benzofused heterocyclic nicotinamide compounds wherein Z is defined as set forth in the '036 application.

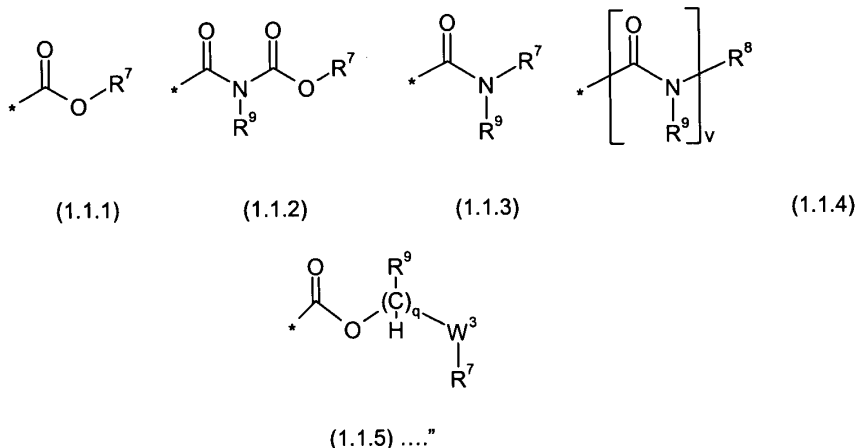
In the '036 application, the variable "Z" takes the place of the variable "D" in the instant application. "Z" is defined therein as being "independently selected from the group consisting of -OR¹², -C(=O)R¹² and -CN, where R¹² is [H, -(C₁-C₄)alkyl, (C₂-C₄)alkenyl, (C₃-C₆)cycloalkyl, phenyl, benzyl or a monocyclic heterocyclic moiety...]."

In the instant application, D is defined, after amendment hereinabove, as being

"independently selected from the group consisting of

— the following —

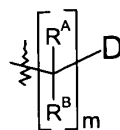
-(a) the group consisting of partial Formulas (1.1.1) through (1.1.5):



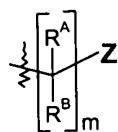
R⁷, R⁸, R⁹, q, v, * and W³ are as defined in amended Claim 1 above.

In instant Claim 1, as amended, D is clearly different from Z of the '036 application. D in the instant application cannot be an ether (OR¹²), a carbonyl (-C(=O)R¹²) group or a cyano group.

Further, the partial structure



of the instant invention, after amendment herein, does not read on the partial structure



of the instant application.

Applicants submit that, after amendment, claim 1 and all claims dependent therefrom are novel over the disclosure of the '036 application. Applicants respectfully request that the Examiner reconsider and withdraw the 35 U.S.C. §102(b) rejection of Claim 1, as amended, and all claims remaining which depend therefrom.

-Conclusion-

Applicants, having responded to all points and concerns raised by the Examiner, believe this application to be in condition for allowance. An early and favorable action is respectfully requested.

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Pfizer Inc.
Patent Department
Eastern Point Road
Groton, CT 06340
(860) 441-5910

Respectfully submitted,

Robert T. Ronau
Robert T. Ronau
Attorney for Applicants
Reg. No. 36,257